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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/468,257	12/20/1999	ANGELA K. HANSON	10990314-1	3407

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EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/468,257

Applicant(s)

HANSON ET AL.

Examiner

Joseph R. Pokrzywa

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 2-4, 15, 22, 24, 31 and 33.Claim(s) objected to: none.Claim(s) rejected: 5, 7-14, 16-20, 25-30, 32, 34 and 35.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____



Joseph R. Pokrzywa
Examiner
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DETAILED ACTION

Period for Reply

1. The shortened statutory period for reply expires THREE MONTHS from the mailing date of the final rejection or as of the mailing date of this advisory action, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Any extension fee required pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for reply expires as set forth above.

Response to Amendment

2. The amendment filed 9/14/04 under 37 CFR 1.116 in reply to the final rejection will be entered upon the filing of an appeal, but is not deemed to place the application in condition for allowance. Upon the filing of an appeal and entry of the amendment, the status of the claims would be as follows:

Allowed claim(s): 2-4, 15, 22, 24, 31, and 33

Rejected claim(s): 5, 7-14, 16-20, 25-30, 32, 34, and 35

Claim(s) objected to: none

Response to Arguments

3. Applicant's arguments filed 9/14/04 have been fully considered but they are not persuasive.

4. In response to applicant's arguments regarding the rejection of ***claim 5***, which was cited as being anticipated by Knowles *et al.* (U.S. Patent Number 5,869,819), whereby applicants argue on pages 12 and 13 that Knowles fails to teach that the required steps are executed sequentially. Knowles teaches of receiving a document from a sending party and printing the document, as read in column 16, lines 25-33, which states the compiled file is "electronically transmitted to a remote site, by e-mail, facsimile transmission, or other protocol available over the Internet, and thereafter printed out using appropriate print-driver software". Continuing, Knowles teaches in column 16, lines 33-37 that the "WWW information resources listed in the compiled information structure can be easily visited by reading the corresponding URL-encoded bar code symbols into the Internet browser program using a bar code scanner". This shows that the document is scanned to obtain at least one communication mark (URL encoded bar code symbol 8), if one is present, on the hardcopy, as is further described in column 17, lines 4-67, which is then decoded by the browser program. Also, the browser program is further described in column 9, line 12-column 10, line 42. Therein, upon decoding the scanned bar-coded symbols, which contain at least a first communication address for a first communication mode and a second communication address for a second different type of communication mode from the communication mark, as seen in Fig. 6B, Knowles teaches of selecting one of the communication addresses and inputting the selected communication address into an address function of a communication device, seen in column 9, lines 11 through 48, and initiating a

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communication to the communication address through the communication device, seen in column 9, line 57-column 10, line 42. Thus, the steps taught by Knowles can be recognized as being sequentially executed.

Therefore, the rejection of independent **claim 5**, as well as independent **claims 11, 20, and 25-28**, as cited in the Office action dated 7/28/04 under 35 U.S.C. 102(e), as being anticipated by Knowles *et al.*, is maintained.

5. In response to applicant's arguments regarding the rejection of dependent **claim 10**, cited as being anticipated by Knowles, applicant argues on pages 13 and 14 that Knowles fails to teach of the limitation requiring the communication mark to be not visible. The examiner agrees that the interpretation of Knowles is different than what is shown in the current invention. The examiner admits that Knowles does not teach that the communication mark can be invisible. However, as the claims are currently written, this feature is not being distinguished. Currently, claim 10 requires that "said communication mark is not visible to the unaided human eye." As discussed in the Office action dated 7/28/04, Knowles is shown to teach in column 17, lines 44 through 50, that the character string length of a URL, in this instance being interpreted as the communication mark, can be shortened. Thus, some of the URL is "not visible to the unaided human eye", as pointed out by the applicant on page 13. However, the claim currently specifies "said communication mark is not visible", whereby the communication mark is interpreted as the entire URL-encoded bar code. If a portion of the communication mark becomes "not visible", then "said communication mark is not visible", as the representation of the communication mark does not contain information that is included in the full communication mark.

Because of this, the rejection of dependent **claim 10**, as cited in the Office action dated 7/28/04 under 35 U.S.C. 102(e), as being anticipated by Knowles *et al.*, is maintained and repeated in this Office action.

6. In response to the rejection of dependent **claim 35**, which the amendment transforms into independent form, whereby the claim was rejected as being unpatentable over Knowles *et al.* in view of Wang *et al.* (U.S. Patent Number 5,513,264), whereby applicant's argue that the modification of Knowles with Wang's teachings would render Knowles system unsatisfactory for its intended purpose, as a human would not be able to view the bar code and therefore, be unable to scan the bar code, thus lacking in motivation to make the proposed modification. As discussed in the Office action dated 7/28/04, the suggestion/motivation for modifying Knowles with Wang's teachings would have been that the system of Knowles would become more secure with the inclusion of Wang's invisible bar codes, as data encoded in the bar code would be invisible to humans, therein not allowing humans to view the information, so as to prevent any stealing or tampering with the code. The applicant argues that the process of Knowles would become impossible with Wang's invisible ink, since human intervention would not be practical, or even possible. As seen in Fig. 15, and read in column 20-column 22, the bar-code scanner is incorporated into an automated device, whereby the scanning step does not need a human to find a bar code, but rather is part of a subsystem for routing packages. With this embodiment of Knowles, using Wang's invisible bar codes would provide a better type of security, since the bar codes would be invisible to humans.

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Because of this, the rejection of **claim 35**, as cited in the Office action dated 7/28/04 under 35 U.S.C. 103(a), as being unpatentable over Knowles *et al.* in view of Wang *et al.*, is maintained and repeated in this Office action.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jrj

Joseph R. Pokrzywa
Examiner
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